

REMARKS/ARGUMENTS

The claims are 1, 4-9, 11-13 and 15-26, claims 27-31 having been withdrawn by the Examiner as being directed to a non-elected invention. Claims 1 and 25 have been amended to incorporate subject matter from claims 3 and 10. Accordingly, claims 3 and 10 have been canceled, and claims 11-13 and 21 which previously depended on claim 10 have been amended to depend on claim 25. Claim 1 has also been amended to improve its form, to conform to the terminology for the first and second film layers used in the specification and to recite that the second film layer is made from a polyolefin or a polyacrylonitrile. Support for the claims can be found, inter alia, in the disclosure in the paragraph bridging pages 2-3, the first full paragraph on page 3, the paragraph bridging pages 3-4 and the first, second and third full paragraphs on page 9. Reconsideration is expressly requested.

Applicant wishes to thank the Examiner for the courtesy of a telephone interview on February 2, 2006, the substance of which is set forth in the Interview Summary of February 2, 2006 and herein. In the Office Action dated October 4, 2005, claims 1, 3-13, 15-24 and 26 were rejected under 35 U.S.C. 112, first

paragraph, as failing to comply with the written description requirement. Specifically, the Examiner considered the recitation in claim 1 "whereby the second film layer faces towards a substrate to be covered with the multilayer film" to be unsupported by the specification as originally filed. Claims 1, 3-13, 15-24, and 26 were also rejected under 35 U.S.C. 112, second paragraph, as being indefinite with respect to this recitation as well.

At the Interview, a proposed amendment to claim 1 substantially as set forth herein was discussed for overcoming this rejection. As amended, claim 1 now recites that the first film layer (such as film layer 2 in FIG. 3) is closer to a substrate (such as roofing membrane 32 shown in FIG. 3) than the second film layer (such as film layer 3). It is respectfully submitted that the foregoing amendment overcomes the Examiner's objection to the claims under 35 U.S.C. §112, first and second paragraph, and Applicant's respectfully request that the objection to the claims on that basis be withdrawn.

In the October 4, 2005 Office Action, claims 1, 3-13 and 15-26 were also provisionally rejected under the judicially created doctrine of obviousness type double-patenting as being

unpatentable over claims 1-17 and 22-31 of Applicant's commonly-owned copending application U.S. Serial No. 10/680,012.

Essentially, the Examiner's position was that the limitations recited in claim 1 were disclosed in claims 1-2 and 25 of the copending '012 application, and thus the scope of claim 1 of the copending '012 application encompasses the subject matter of claim 1 of the instant application, rendering that subject matter obvious over each other.

At the Interview, Applicant pointed out that the claims in the copending '012 application have been changed, and that the claims as amended substantially as set forth herein overcame the double patenting rejection. Attached hereto are the pending claims of Applicant's commonly-owned copending '012 application. It is respectfully submitted that the copending '012 application claims are not broader than Applicant's invention as recited in the claims herein.

For example, the copending '012 application claims are directed to a film-bitumen combination whereas the present claims are directed to a multilayer film suitable as a release film and a release film comprising that multilayer film. In the copending '012 application, a bituminous layer is required. Also, the

claims in the copending '012 application require two film layers in which the first edge projects beyond the bituminous layer and the second edge of the film layers is shorter than the bituminous layer. Accordingly, it is respectfully submitted that the claims of the copending '012 application are not broader than the claims as set forth herein, that the claims set forth herein are not obvious over the '012 application claims or vice versa, and that there is no double patenting with respect to the copending '012 application claims.

In the October 4, 2005 Office Action, claims 1, 3, 8, 10-13, 15, and 17-26 were also rejected under 35 U.S.C. 102(b) as being anticipated by *Stierli U.S. Patent No. 4,442,148*. The remaining claims 4-7, 9, and 16 under consideration were rejected under 35 U.S.C. 103(a) as being unpatentable over *Stierli* in view of *Bochow et al. U.S. Patent No. 5,449,552*. Essentially, the Examiner's position was that *Stierli* discloses the film recited in the claims except for teaching a layer comprising polypropylene, polyamide, polyethylene terephthalate or a mixture thereof, that *Bochow* discloses this feature, and that it would have been obvious to one of ordinary skill in the art, to have employed polypropylene, polyamide, polyethylene terephthalate or a mixture thereof, or a lacquer, as taught by *Bochow*, in the

have been obvious to one of ordinary skill in the art, to have employed polypropylene, polyamide, polyethylene terephthalate or a mixture thereof, or a lacquer, as taught by *Bochow*, in the barrier layer of *Stierli*, because both *Stierli* and *Bochow* disclose that these thermoplastic compounds are alternative of each other and the use of these compounds would have given the same results.

At the Interview the rejection the claims over *Stierli* and *Bochow* was discussed in view of a proposed amendment as substantially set forth herein, and the Examiner indicated that the proposed amendment appeared to distinguish over *Stierli* and *Bochow* subject to further consideration. As it is believed that claims 1 and 25, as amended herein, are patentable over the cited references, Applicant respectfully traverses the rejection for the following reasons.

Applicant's invention deals only with a multilayer release film and not with a sealing structure, such as is described in *Stierli*. As set forth in claim 1, as amended, Applicant's invention provides a multilayer film (shown, for example as 21, in FIG. 2). The film has at least two film layers (e.g. layers 2

and 3) made from different materials having different coefficients of thermal expansion. The second film layer (layer 3) is made from a polyolefin or a polyacrylonitrile and has a larger coefficient of thermal expansion than the first film layer (layer 2). The first film layer (layer 2) is made from a polyolefin and is adapted to be closer to a substrate to be covered with the multilayer film than the second film layer (layer 3). At least the first film layer (layer 2) is configured to provide a barrier against mineral oil, and at least one surface of the multilayer film is treated so that it has low bonding properties (see silicone coating 5) and therefore makes the multilayer film suitable as a release film.

As set forth in claim 25, as amended, Applicant's invention provides a multilayer film with at least two film layers 2 and 3 made from different materials. At least one film layer 2 is made from a polyolefin and includes a barrier layer against mineral oils, and at least one surface of the multilayer film is treated so that it has low bonding properties.

Applicant's films as set forth in claim 1 and 25, as amended, are particularly suitable for use as a release film for membranes that contain oil. Moreover, as specifically recited in claim 1, as amended, by providing the film layer located further

away from the substrate to be covered with a larger coefficient of thermal expansion than the film layer located closer, the edges of the film combination are pressed against the substrate which prevents unintentional detachment.

Stierli fails to disclose a multilayer film suitable as a release film as recited in claim 1 and 25, as amended. *Stierli* simply discloses a removable protective sheet 4 that is siliconized paper. *Stierli* also discloses a bituminous membrane 1, an oil impermeable polymeric coating 2, and a support sheet 3. Thus, *Stierli* fails to show first and second film layers wherein the first film layer is adapted to be closer to a substrate to be covered with a multilayer film, is made from a polyolefin, and is configured to provide a barrier against mineral oils as recited in claim 1, as amended. The bituminous membrane 1 of *Stierli* contains mineral oil and does not provide a barrier. Support sheet 3 of *Stierli* likewise is not configured to provide a barrier layer. Polymeric coating 2 of *Stierli* is not made from a polyolefin as recited in claim 1, as amended with respect to the first film layer that is configured to provide a barrier against mineral oils.

With respect to claim 25, as amended, *Stierli* fails to disclose at least one film layer made from polyolefin and

including a barrier layer against mineral oils. Again, the only barrier layer in *Stierli* is polymeric coating 2 which is not made from polyolefin.

The defects and deficiencies of the primary reference to *Stierli* are nowhere remedied by the secondary reference to *Bochow et al.* *Bochow et al.*'s film is directed to avoiding curling by moisture by using a gas barrier against the membrane. Although *Bochow et al.* uses a barrier layer, there is no disclosure or suggestion of using the gas barrier layer of *Bochow et al.* as a barrier layer for mineral oils or in a release film to be placed on a bituminous layer. In contrast to *Bochow et al.*, which seeks to avoid curling through the use of a gas barrier layer, Applicant's invention as set forth in claims 1 and 25, as amended, uses a special combination of film layers to achieve the anti-curling effect.

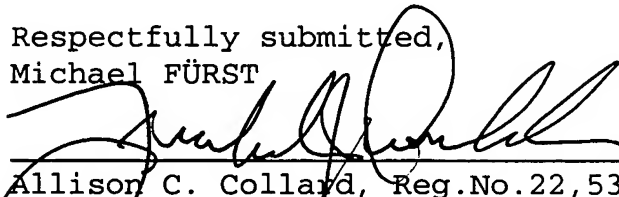
Accordingly, it is respectfully submitted that Applicant's invention as recited in claim 1 and 25, as amended, and the dependent claims 4-9, 11-13, 15-24, and 26 are patentable over the cited references.

In summary, claims 1, 11-13, 21 and 25 have been amended, and claims 3 and 10 have been canceled. In view of the

foregoing, it is respectfully requested that the claims be allowed, and that this application be passed to issue.

Applicant also submits herewith an Information Disclosure Statement.

Respectfully submitted,
Michael FÜRST



COLLARD & ROE, P.C.
1077 Northern Boulevard
Roslyn, New York 11576
(516) 365-9802

Allison C. Collard, Reg.No.22,532
Frederick J. Dorchak, Reg.No.29,298
Attorneys for Applicant

FJD:djp

Enclosure: Listing of Claims 1-31 Pending in U.S. Application
Serial No. 10/680,012 (M. FÜRST - 1) and
an Information Disclosure Statement

I hereby certify that this documentation is being deposited with the United States Postal Service as first class mail in an envelope addressed to:
COMMISSIONER FOR PATENTS, MAIL STOP: Amendment, P.O. Box 1450, Alexandria, VA 22313-1450 on February 3, 2006.


Kelly Espitia